



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,793	06/12/2007	Gottfried Brem	KLAUS1.004APC	1110
20995 7590 04/29/2009 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER STALEY, KRISTINA N	
			ART UNIT 3611	PAPER NUMBER
			NOTIFICATION DATE 04/29/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/590,793	<b>Applicant(s)</b> BREM ET AL.	
	<b>Examiner</b> KRISTINA STALEY	<b>Art Unit</b> 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 16-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 16-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/25/2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to because the shading and quality of all of the figures makes it hard to see parts and corresponding numbers. Also, the Figures are not numbered, making it hard to reference to them. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites the limitation "the front end" in line 12. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 16, 19, 21, 24-27, and 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Caisley (WO 02/39810).**

Referring to Claims 1, 16, and 25: Caisley discloses a device configured to mark and concurrently collect a sample from an individual (pg. 1, lines 28-32), the device comprising:

a spike (Figure 8, #120); and a female part of a tag (Figure 8, #101), comprising:

a tag part containing a through opening (Figure 4, #26); and

a chamber including a chamber-part (Figure 4, #1) and a ring-part (Figure 4, #15)

arranged on opposite sides of a through opening (Figure 4, #26) of the female part of

the tag (Figure 4, #32), wherein the chamber-part and the ring-part are each

Art Unit: 3611

substantially formed of plastic (pg. 9, lines 24-25, pg 17, lines 18-19 and lines 29-30), and wherein the spike is configured to receive means for collecting a sample and for closing a container (pg. 7, lines 15-18), wherein the spike comprises an outer diameter which increases from a front end (Figure 9, #122) to a maximum and decreases stepwise to an outer diameter (Figure 8, #121) essentially corresponding to an outer diameter of the ring-part (Figure 8, #11), to form a head, and the chamber (Figure 8, #11) is configured such that once the head (Figure 8, #120) is introduced into the chamber, the chamber substantially prevents the spike (Figure 8, #150) from being removed from the female part (Figure 8, #110) of the tag (pg. 20, claim 2, lines 5-7).

Referring to Claims 19 and 30: Caisley discloses a ring-part (Figure 4, #15) comprising a conical area surrounding a through opening (Figure 4, #26), the conical area configured to assist introduction of a spike head into a ring part (pg. 9, lines 32-35).

Referring to Claims 21 and 31: Caisley discloses a chamber-part with protrusions (Figure 3, #17 and #15) configured to extend into recessions formed in a female part (Figure 3, #18) of the tag.

Referring to Claim 24: Caisley discloses a tag marked with an electronic identification device (pg. 4, lines 31-33).

Referring to Claims 26, 27, and 34: Caisley discloses a tag being placed on a non-human animal, namely a pet (pg. 1, lines 15-16).

Referring to Claim 29: Caisley discloses a method of marking and concurrently taking a sample of an individual, the method comprising:

Art Unit: 3611

collecting a tissue sample from the individual; and applying a tag to the individual (pg. 1, lines 28-32) by connecting a spike (Figure 8, #122) to a chamber (Figure 8, #14) through a ring part (Figure 8, #105), a container being releasably attached to the chamber (pg. 19, claim 1, line 36), wherein the tissue sample is placed in the container, the container is closed (pg. 19, claim 1, lines 28-29), the spike enters the chamber such that the spike cannot be removed from the chamber (pg. 3, lines 1-6), and the closed container containing the tissue sample is released from the chamber (pg. 19, claim 1, lines 36-37).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Caisley (WO 02/39810) as applied to claim 1 above, and further in view of Tarver (US 3,399,478).**

Caisley does not specifically teach that the plastic of the tag comprises polyamide. Tarver teaches an ear tag formed of plastic comprising polyamide (col. 1, lines 81-82). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Tarver into the invention of Caisley in order to provide construct a tag out of a material which is non-toxic and would not affect a biological sample in any way.

**Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Caisley (WO 02/39810) as applied to claim 1 above, and further in view of Pfistershammer (WO 2004/010773).**

Caisley does not teach the parts of the chamber being connected by ultrasonic welding. Pfistershammer teaches parts of an ear tag being formed by ultrasonic welding (pg. 9, lines 18-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Pfistershammer into the invention of Caisley as it is a common method for connecting solid state plastics.

**Claims 20, 22, 23, 28, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caisley (WO 02/39810) as applied to claims 1, 25, and 29 above, and further in view of Haar et al. (US 6,708,432) (Haar).**

Referring to Claim 20: Caisley does not teach a ring part extending through an opening of the female part of the tag to contact a chamber part. Haar teaches an ear tag

Art Unit: 3611

with a ring part (Figure 8, #42) having a form (Figure 8, #46) extending through an opening (Figure 8, #44) of a female part of a tag (Figure 8, #22) to contact a chamber part (Figure 8, #50) of a chamber (Figure 8, #52). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Haar into the invention of Caisley in order to provide a more secure fit between the separate pieces of the chamber.

Referring to Claims 22 and 32: Caisley does not teach recessions in a ring-part of a chamber into which protrusions extend. Haar teaches protrusions (Figure 8, #54) which extend through respective openings (Figure 8, #44) of a female-part of a tag (Figure 8, #22), and protrusions on a ring-part of the tag (Figure 8, #46) which extend into respective recessions of a chamber part (Figure 8, #52). It would have been a simple reversal of parts to one of ordinary skill in the art at the time of the invention to place protrusions on the chamber part and recessions on the ring-part, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Haar into the invention of Caisley in order to interlock the separate pieces of the tag and avoid accidental damage to the tag when it comes in contact with a hard surface.

Referring to Claims 23 and 33: Caisley does not teach a recess around an opening in the female part of the tag for receiving a ring-part of the chamber. Haar teaches an ear tag with a female part of the tag (Figure 8, #22) having a recess (Figure 8, #40) arranged around a through opening (Figure 8, #44) and configured to receive a



Art Unit: 3611

ring-part (Figure 8, #42) of a chamber (Figure 8, #52). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Haar into the invention of Caisley in order to more securely attach the ring-part to the female part of the tag and avoid accidental breakage.

Referring to Claim 28: Caisley does not teach tagging a deceased animal. Haar teaches a tag on a deceased animal (col. 1, lines 44-46). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Haar into the invention of Caisley and tag a deceased animal for consumption purposes.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brem (US 6,509,187); Brem (US 7,198,629); Brem (US 6,968,639).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTINA STALEY whose telephone number is (571)270-7816. The examiner can normally be reached on Monday through Thursday, 8:00AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. S./

Examiner, Art Unit 3611

/Lesley D. Morris/

Supervisory Patent Examiner, Art Unit 3611